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EXAMINER

SCHUBERT, KEVIN R

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/934,195

Applicant(s)

SOWLER, JONATHAN

Examiner

Kevin Schubert

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 1-35 have been considered.

***Claim Rejections - 35 USC § 102***

5           The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

10           (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson, U.S. Patent No. 6,209,095.

20           As per claims 1,9,13,17,24, and 31, the applicant describes a method for forming and verifying a service message for a multi-service environment comprising the following limitations which are met by Anderson:

a) digitally signing one or more message components for a first part of a service message (Col 39, lines 21-39);

25           b) digitally signing one or more message components for a second part of said service message (Col 39, lines 21-39);

c) forming said service message from said first and second parts, and first and second digital signatures of said first and second parts (Col 39, lines 21-39);

d) receiving said service message at a server (Col 39, lines 21-39);

30           e) partitioning said service message at said server into a first partition and a second partition, wherein said first partition comprises said first part of said service message and said first digital signature,

Art Unit: 2137

and wherein said second partition comprises said second part of said service message and said second digital signature (Col 39, lines 21-39);

f) sending said first partition from said server to a first service in said multi-service environment (Col 39, lines 21-39);

5 g) verifying said first part of said service message at said first service using said first digital signature (Col 39, lines 21-39; Col 10, lines 4-6);

h) sending said second partition from said server to a second service in said multi-service environment (Col 39, lines 21-39);

i) verifying said second part of said service message at said second service using said second  
10 digital signature (Col 39, lines 21-39; Col 10, lines 4-6).

As per claims 2,21, and 25, the applicant describes the method of claims 1,17, and 24, which are met by Anderson, with the following limitation which is also met by Anderson:

Wherein at least one message component is common to both said first and second parts of said  
15 service message (Col 31, lines 21-39);

As per claims 3,20, and 26, the applicant describes the method according to claims 1,17, and 24, which are met by Anderson, with the following limitation which is also met by Anderson:

Further comprising associating one or more message components relating to a first service with  
20 each other to form said first part, and associating said one or more message components relating to a second service with each other to form said second part (Col 39, lines 21-39).

As per claims 4 and 22, the applicant describes a method according to claims 1 and 20, which are met by Anderson, with the following limitation which is also met by Anderson:

25 Wherein said service message includes one or more message blocks, each comprising one or more message components (Col 10, lines 39-43).

Art Unit: 2137

As per claims 5 and 28, the applicant describes a method according to claims 4 and 27, which are met by Anderson, with the following limitation which is also met by Anderson:

Wherein at least one message block is common to both said first and second parts of said service message (Fig 6, Col 39, lines 21-39);

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As per claims 6,23, and 29, the applicant describes the method according to claim 5,22, and 27, which are met by Anderson, with the following limitation which is also met by Anderson:

Wherein two or more blocks comprising one of said first and second parts of said message are related to each other (Fig 6, Col 39, lines 21-39).

10

As per claims 7,18, and 30, the applicant describes the method of claims 1,17, and 24, which are met by Anderson, with the following limitation which is also met by Anderson:

Further comprising forming said service message such that cryptographic data for said service message is disposed in a separate part of said message from said first and second parts (Col 12, lines 1-9);

15

Appended certificates can form a separate part of the message from said first and second parts.

As per claims 8,10,11,15,33, and 35, the applicant describes a method for decoding a service message comprising first and second parts respectively associated with first and second services of a multi-service environment comprising the following limitations which are met by Anderson:

20

a) partitioning said service message into a first partition and a second partition, wherein said first partition comprises said first part of said service message, and wherein said second partition comprises said second part of said service message (Col 23, lines 31-60);

b) receiving said first partition of said service message at a first service (Col 23, lines 31-60);

25

c) verifying only said first part of said message at said first service (Col 23, lines 31-60);

d) receiving said second partition of said service message at a second service (Col 23, lines 31-60);

60);

Art Unit: 2137

e) verifying only said second part of said service message at said second service (Col 23, lines 31-60);

The first part of the service message is the memorandum which is received at a first service, the payer (part b). The payer verifies only the memorandum (part c) and then partitions the service message into a first part and a second part by attaching an instrument (part a). The second partition (the instrument) is received at a second service such as the payee or a bank which validates only the instrument.

As per claims 12,14,16,32, and 34, the applicant describes program code with the following

limitations which are met by Anderson:

a) verify only said first part of said message for said first service (Col 23, line 31 to Col 24, line 15);

b) verify only said second part of said message for said second service (Col 23, line 31 to Col 24, line 15);

c) wherein at least one message component is common to both said first and second parts of said message (Col 23, line 31 to Col 24, line 15);

Regarding part c), with the first part (memorandum) and the second part (instrument) contain the payee's digital signature.

As per claims 19, and 27, the applicant describes an electronic signal according to claims 17 and 24, which are met by Anderson, with the following limitation which is met by Anderson:

Wherein said first part of said message is associated with a first service, and said second part of said message is associated with a second service (Col 39, lines 21-39).

### ***Response to Arguments***

Applicant's arguments, see Remarks filed 5/12/05, with respect to claim 1 have been fully considered but they are not persuasive. The applicant argues that newly-added parts e,f, and h of claim

Art Unit: 2137

1 are not taught by Anderson. The examiner disagrees. The examiner points to Anderson's passage about how a medical record is signed and distributed in the system (Col 39, lines 21-39 and Col 9, line 41 to Col 10, line 6). A first doctor digitally signs one or more message components for a first part (part a) and then passes the service message to a second doctor who receives the message, digitally signs one  
5 or more message components, and thereby forms a modified service message (parts b,c, and d). The server of the second doctor also partitions the service message by adding a second digital signature. When the service message was received at the server of the second doctor, it only had a first part (the first digital signature). By adding a second digital signature at the server of the second doctor, the server partitions the message into a first part (related to the first doctor) and a second part (related to the second  
10 doctor) (part e). The server can then send the message comprising the first and second parts to a number of third party services such as insurance companies, administrators, etc, who can verify the parts of the message by decrypting the digital signatures (parts f,g,h, and i).

Applicant's arguments with respect to claim 2 have been fully considered but they are not  
15 persuasive. The applicant argues that though both the electronic check and the deposit instrument have an "AMOUNT" component, the component may indicate different amounts. The examiner agrees and was aware of this when the rejection was written. However, the applicant has claimed in claim 2 that "at least one message component is common". By both having an "AMOUNT" component, both the electronic check and the deposit instrument have a message component in common. A date component,  
20 a memo component, and a certificate component are also common to both the electronic check and the deposit instrument. The examiner also notes that the limitations' broad scope could be rejected a number of ways. For one, the medical record form has a first and a second part which both contain a digital signature. Therefore, at least one message component is common to both the first and second parts because they both have a digital signature component in common.

### **Conclusion**

Art Unit: 2137

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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